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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,175	04/22/2004	Hans-Josef Sterzel	9442-26	5942

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EXAMINER
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VIJAYAKUMAR, KALLAMBELLA M

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/829,175

Applicant(s)

STERZEL, HANS-JOSEF

Examiner

Kallambella Vijayakumar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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### **Detailed Action**

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

The preliminary amendment filed 04/22/2004 has been entered. Claims 1-8 and 10 are currently pending with the application.

The examiner has considered the IDS filed 04/22/2004 and 08/11/2004.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 4-5 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "elevated temperature" is a relative term which renders the claim indefinite. The term "elevated temperature" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. What applicant considers as an elevated temperature may not be an elevated temperature to a person of ordinary skilled in the art with respect to his/her reference point.

Claim 4 recites the limitation of "the first component for the reaction forming water of reaction" in Line-3 and there is insufficient antecedent basis for this limitation. It is not clear what components are encompassed by this limitation.

Claim 5 recites the limitation of "the first component to the second component for the reaction forming water of reaction" in Line 3 and there is insufficient antecedent basis for this limitation. It is not clear what components are encompassed by this limitation.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 8 and 10 are rejected under 35 U.S.C. 102(b) as being Amatucci by US 2002/0102205.

Amatucci teaches a Li-Ti-Oxide-spinel with a particle size of less than 100 nm and a rechargeable battery containing the spinel oxide (Abstract, Para 0008; 0041) and "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). All the limitations of the instant claims are met.

The reference is anticipatory.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kavan et al (ECS, 2002, 5(2) A39-A42) further in view of either Bruno et al (US 5,242,674) or Idota (US 5,571,637).

Kavan et al teaches the synthesis of  $\text{Li}_4\text{Ti}_5\text{O}_{12}$  spinel by reacting lithium ethoxide and Ti(IV)-alkoxide in an alcoholic media forming nanocrystalline material and its function as an electrode material (Abstract). The Li-Ti-O spinels included compositions with the formula  $\text{Li}_{1+x}\text{Ti}_{2-x}\text{O}_4$ ;  $0 \leq x \leq 1/3$  that are electrode active materials (Pg A-39; C-1, Para1-2; Pg-A41, Fig-4). The prior art teaches mixing the components and hydrolyzing with water and concentrating the contents to a concentration of 10-20 wt% at 40°C and 20 mbar pressure, adding PEG and coating a glass substrate followed by calcination at 500°C for 30 mins (Pg A39, Experimental). The formation of water due to the decomposition of alkoxide and/or the hydroxide in the process would meet the limitation of "water of reaction" in claim-1.

The prior art is silent about using other precursors of Li such as Li-hydroxide in making the mixed oxide composition per claim-1, and the process conditions per the claim-3.

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In the analogous art of mixed metal oxides, Bruno et al teach making mixed metal oxides by reacting Li salts such as Li-OH and Li-acetate (organic salt of Li) with organometallic salts of metals such as alkoxides and acetylacetonates of Ti in presence of alcohol and optimizing the particle size of resultant mixed oxide by controlling the process temperature and the elemental ratios (C-1, Ln 20-43, C-2, Ln 30-40, 56-60; C-4, Ln 30-40; C-7, Ln 46-57).

In the analogous art of electrode/batteries, Idota teaches making positive electrode materials with spinel structure by reacting Li salts such as Li-OH and Li-oxo-acid salts (organic salt of Li) with organometallic salts of metals such as acetylacetonates of Ti. The particle size of the electrode material ranged from 0.1-50 micron (C-7, Ln 27-30; C-3, Ln 12-50; C-4, Ln 60-65).

It would be obvious to a person of ordinary skilled in the art to combine the prior art teachings to substitute the Li-ethoxide of Kavan et al with Li-hydroxide in the making of the Li-Ti-O as functional equivalent with reasonable expectation of success, because the prior art teachings are in the analogous art of mixed oxides and/or electrodes, and because Kavan discloses that Li-carbonate/hydroxide can be used in the synthesis of nanocrystalline Li-Ti-O spinel (Pg-A39, Para-3; Pg-A40, Results and Discussion, Col-1).

With regard to claim-3, the prior art teaches making the composition at 40C and 20 mbar or hydrothermally at 150C. Also, with respect to the temperature and pressure, the optimization and selection of such reaction parameters would have been obvious to one of ordinary skill in the art at the time the invention was made because reaction parameters are recognized to have been result-effective variables. As to optimization results, a patent will not be granted based upon the optimization of result effective variables when the optimization is obtained through routine experimentation unless there is a showing of unexpected results which properly rebuts the *prima facie* case of obviousness. See *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). See also *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

With regard to claims 7-8 and 10, the prior art teaches a particle size of about 9-nm and an electrode comprising the composition (Pg-A40, Fig-1; C-2, Para-3). The prior art composition is similar to that by the

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applicant's and "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 and 7 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3 and 6-9 of copending Application No. 10/847,620.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to a process of making mixed metal oxides starting from similar components and reacting at similar conditions and forming products with similar particle size. The Ti-alkoxide and Li-hydroxide of instant application is encompassed by the components in the copending 10/847,620. The instant application differs from copending 10/847,620 in that it requires preparing a spinel by the formation of water of reaction that would be obvious because of similar process operating on similar components.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kallambella Vijayakumar whose telephone number is 571-272-1324. The examiner can normally be reached on 8.30-6.00 Mon-Thu, 8.30-5.00 Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571-272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KMV  
September 22, 2006.

  
DOUGLAS MCGINTY  
SUPERVISORY PATENT EXAMINER

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